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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/611,955 | 07/06/2000 | Cyprian Emeka Uzoh | FI9-97-205B | 6678 |

32074 7590 04/07/2004

INTERNATIONAL BUSINESS MACHINES CORPORATION
DEPT. 18G
BLDG. 300-482
2070 ROUTE 52
HOPEWELL JUNCTION, NY 12533

EXAMINER

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Communication Re: Appeal

Application No.

09/611,955

Applicant(s)

UZOH ET AL.

Examiner

Hung K. Vu

Art Unit

2811

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

1. ☐ The Notice of Appeal filed on _____ is not acceptable because:

(a) ☐ it was not timely filed.

(b) ☐ the statutory fee for filing the appeal was not submitted. See 37 CFR 1.17(b).

(c) ☐ the appeal fee received on _____ was not timely filed.

(d) ☐ the submitted fee of \$_____ is insufficient. The appeal fee required by 37 CFR 1.17(b) is \$_____.

(e) ☐ the appeal is not in compliance with 37 CFR 1.191 in that there is no record of a second or a final rejection in this application.

(f) ☐ a Notice of Allowability, PTO-37, was mailed by the Office on _____.

2. ☒ The appeal brief filed on 11/25/03 is NOT acceptable for the reason(s) indicated below:

(a) ☐ the brief and/or brief fee is untimely. See 37 CFR 1.192.

(b) ☐ the statutory fee for filing the brief has not been submitted. See 37 CFR 1.17(c).

(c) ☐ the submitted brief fee of \$_____ is insufficient. The brief fee required by 37 CFR 1.17(c) is \$_____.

(d) ☒ see Attachment.

The appeal in this application will be dismissed unless corrective action is taken to timely submit the brief and requisite fee. Extensions of time may be obtained under 37 CFR 1.136(a).

3. ☐ The appeal in this application is DISMISSED because:

(a) ☐ the statutory fee for filing the brief as required under 37 CFR 1.17(c) was not timely submitted and the period for obtaining an extension of time to file the brief under 37 CFR 1.136 has expired.

(b) ☐ the brief was not timely filed and the period for obtaining an extension of time to file the brief under 37 CFR 1.136 has expired.

(c) ☐ Request for Continued Examination (RCE) under 37 CFR 1.114 was filed on _____.

(d) ☒ other: See Attachment

4. ☐ Because of the dismissal of the appeal, this application:

(a) ☐ is abandoned because there are no allowed claims.

(b) ☐ is before the examiner for final disposition because it contains allowed claims. Prosecution on the merits remains CLOSED.

(c) ☐ is before the examiner for consideration of the submission and prosecution has been reopened pursuant to 37 CFR 1.114.

Hung Vu
HUNG VU
PATENT EXAMINER

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, according to the proposed drawings, dated 07/16/02, which had been approved by Examiner, the electrical insulating layer located over at least one major surface and in recesses, as recited in claim 25, must be shown or the feature(s) canceled from the claim(s). Note that Figure 3 shows recesses 2 located in the insulating layer 3, not an insulating layer 3 located in the recesses 2. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

2. The amendment filed 12/23/02 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: recesses 2 are formed in at least one major surface of the semiconductor substrate. Note that, according to the proposed drawings, dated 07/16/02, which had been approved by Examiner, the electrical insulating layer located over at least one major surface and recesses are formed in the electrical insulating layer.

Claim Objections

3. Claim 25 is objected to because of the following informalities:

In claim 25, line 2, “in” should be changed to “on” for clarity. Note that the specification, at page 7, lines 16-18, and page 13, lines 2-4, only describes recesses located on at least one major surface of the semiconductor substrate. Also, according to the proposed drawings which had been approved by Examiner, recesses located in the insulating layer which is located on at least one major surface of the semiconductor substrate.

Appropriate correction is required.

The United States Patent and Trademark Office (Office) in administering the Patent Laws makes many decisions of a discretionary nature which the applicant may feel deny him or her the patent protection to which he or she is entitled. The differences of opinion on such matters can be justly resolved only by prescribing and following judicial procedures. Where the differences of opinion concern the denial of patent claims because of prior art or material deficiencies in the disclosure set forth in the application, the questions thereby raised are said to relate to the merits, and appeal procedure within the Office and to the courts has long been provided by statute.

The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Commissioner of Patents and Trademarks should be carefully observed. The Board will not ordinarily hear a question which it believes should be decided by the Commissioner, and the Commissioner will not

Art Unit: 2811

ordinarily entertain a petition where the question presented is an appealable matter.

However, since 37 CFR 1.181(f) states that any petition not filed within 2 months from the action complained of may be dismissed as untimely and since 37 CFR 1.144 states that petitions from restriction requirements must be filed no later than appeal, petitionable matters will rarely be present in a case by the time it is before the Board for a decision. In re Watkinson, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990).

A shortened statutory period for reply to this action is set to expire **TWO MONTH** from the mailing date of this letter.